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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,792	07/31/2001	Alan D. Gould	50442.010200	9535
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EXAMINER ALVAREZ, RAQUEL				
ART UNIT 3688		PAPER NUMBER		
NOTIFICATION DATE 07/02/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

09/917,792

Applicant(s)

GOULD ET AL.

Examiner

Raquel Alvarez

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 3/20/2008.
2. Claims 27-31 have been added. Claims 1-24 and 26-31 are present for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 8, 10-15, 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (5,759,101 hereinafter Von Kohorn).

With respect to claims 1, 3, 8, 10, 11, 26-27, 31 Von Kohorn teaches a method of conducting an incentivized trivia contest to increase the effectiveness of advertising (col. 44, lines 55 to col. 45, lines 1-5). Storing in a computer system a set of trivia questions relating to advertising content (col. 44, lines 55 to col. 45, lines 1-5); additionally storing in said computer system a second set of trivia questions relating to show content (col. 2, lines 42-59); associating said first and second sets of trivia questions with a broadcast of said advertising content along with said show content (i.e. questions may be asked in conjunction with the broadcast commercial and program (col. 3, lines 44-46, col. 16, lines 16-19 and col. 44, lines 55-62); selecting a subset of

said first and second trivia questions to ask a member (Figure 28); transmitting said subset of trivia questions to said member and receiving said member's responses thereto via a communication medium (Figure 28, 842); scoring said member's performance in response to said subset of trivia questions (Figure 28, 838); providing incentives to said member based upon results of said scoring (Figure 28, 844).

With respect to claim 2, Von Kohorn further teaches storing data indicative of which advertising airs in conjunction with said broadcast (i.e. certain commercial may be aired for various product and/or services targeted or tailored to the viewing audience)(col. 3, lines 44-46 and col. 16, lines 16-19).

With respect to claims 4-5, Von Kohorn further teaches that the broadcast comprises radio broadcast and a network connection (col. 7, lines 11-34).

With respect to claims 12, 28-30 Von Kohorn teaches a method of using a user profile to conduct a trivia contest (col. 135, lines 5-27). Storing in a computer system a set of trivia questions relating to advertising content (col. 44, lines 55 to col. 45 lines 1-5); storing in said computer system a second set of trivia questions relating to show content (col. 2, lines 42-59); associating said first and second sets of trivia questions with a broadcast of said advertising content along with said show content (i.e. questions may be asked in conjunction with the broadcast commercial and program (col. 44, lines 55-62); selecting a subset of said first and second trivia questions to ask a member

(Figure 28); storing in said computer system a demographic profile of at least one member (i.e. the respondent's gender, residence, income etc. is collected and stored in order to limit respondents to the desired groups)(col. 135, lines 5-27); using said demographic profile to select a subset of said first and second trivia questions to ask said member (col. 135, lines 5-27); transmitting said subset of trivia questions to said member and receiving said member's responses thereto via a communication medium (Figure 28, 842).

With respect to claim 13, Von Kohorn further teaches that the broadcast comprises radio broadcast and a network connection (col. 7, lines 11-34).

With respect to claims 14-15 Von Kohorn teaches a method of determining advertising performance and product placement (col. 44, lines 55 to col. 45, lines 1-5). Storing in a computer system a set of trivia questions relating to advertising content (col. 44, lines 55 to col. 45, lines 1-5); storing in said computer system a second set of trivia questions relating to show content (col. 2, lines 42-59); associating said first and second sets of trivia questions with a broadcast of said advertising content along with said show content (i.e. questions may be asked in conjunction with the broadcast commercial and program (col. 3, lines 44-46, col. 16, lines 16-19 and col. 44, lines 55-62); selecting a subset of said first and second trivia questions to ask a member (Figure 28); transmitting said subset of trivia questions to said member and receiving said member's responses thereto via a communication medium (Figure 28, 842); and determining advertising performance and product placement based upon said member's answers to

Art Unit: 3688

said subset of trivia questions (i.e. advertisement's performance is determined based upon member's recall to the questions related to the goods or services presented) (col. 44, lines 55 to col. 45, lines 1-5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-7, 9, 16-24 and rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn in view of Official Notice.

Claims 6 and 7 further recite wherein said network comprises an Internet connection. Von Kohorn teaches that the broadcast is via a network connection (col. 7, lines 11-34). Von Kohorn doesn't specifically teach that the network comprises an Internet connection. Official notice is taken that it is old and well known in the computer network arts to use Internet connection because such a modification facilitates communication around the world. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included for said network to have comprised Internet connection in order to obtain the above mentioned advantage.

Claim 9 further recites that the communication medium comprises a set-top box. Official notice is taken that set-top boxes are old and well known to be used to perform computing functions that don't require much computing power at a fraction of the cost of a full computer. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a set-top box in order to obtain the above mentioned advantage.

With respect to claims 16-19, Von Kohorn teaches a method of the effectiveness of advertising (col. 44, lines 55 to col. 45, lines 1-5). Storing in a computer system a set of trivia questions relating to advertising content (col. 44, lines 55 to col. 45, lines 1-5); storing in said computer system a second set of trivia questions relating to show content (col. 2, lines 42-59); associating said first and second sets of trivia questions with a broadcast of said advertising content along with said show content (i.e. questions may be asked in conjunction with the broadcast commercial and program (col. 3, lines 44-46, col. 16, lines 16-19 and col. 44, lines 55-62); selecting a subset of said first and second trivia questions to ask a member (Figure 28); transmitting said subset of trivia questions to said member and receiving said member's responses thereto via a communication medium (Figure 28, 842); scoring said member's performance in response to said subset of trivia questions (Figure 28, 838); providing incentives to said member based upon results of said scoring (Figure 28, 844).

With respect to creating a report indicative of effectiveness of said advertising content based at least in part on said member's responses and demographic profiles.

Von Kohorn teaches effectiveness of advertisements/commercials based on member's responses and maintaining demographic profiles on the members (col. 44 lines 55 to col. 45, lines 1-5 and col. 135, lines 5-27). With respect to preparing a report. Official notice is taken that it is old and well known to prepare a report on information gathered because such a modification would provide a detailed account of the information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included creating a report indicative of effectiveness of said advertising content based at least in part on said member's responses and demographic profiles in order to obtain the above mentioned advantage.

With respect to claim 20, Von Kohorn teaches a method of conducting an incentivized trivia contest to increase the effectiveness of advertising content, determine advertising content performance, and determine show content performance (col. 135, lines 5-27). Storing in a computer system a set of trivia questions relating to advertising content (col. 44, lines 55 to col. 45 lines 1-5); additionally storing in said computer system a second set of trivia questions relating to show content (col. 2, lines 42-59); associating said first and second sets of trivia questions with a broadcast of said advertising content along with said show content (i.e. questions may be asked in conjunction with the broadcast commercial and program (col. 44, lines 55-62); selecting a subset of said first and second trivia questions to ask a member (Figure 28); storing in said computer system a demographic profile of at least one member (i.e. the respondent's gender, residence, income etc. is collected and stored in order to limit

respondents to the desired groups)(col. 135, lines 5-27); using said demographic profile to select a subset of said first and second trivia questions to ask said member (col. 135, lines 5-27); transmitting said subset of trivia questions to said member and receiving said member's responses thereto via a communication medium (Figure 28, 842);); scoring said member's performance in response to said subset of trivia questions (Figure 28, 838); providing incentives to said member based upon results of said scoring (Figure 28, 844).

With respect to using answers from the first and second sets of trivia questions to create a report indicative of effectiveness of said advertising content. Von Kohorn teaches effectiveness of advertisements/commercials based on member's responses (col. 44 lines 55 to col. 45, lines 1-5) . With respect to preparing a report. Official notice is taken that it is old and well known to prepare a report on information gathered because such a modification would provide a detailed account of the information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included creating a report indicative of effectiveness of said advertising content based at least in part on said member's responses to the first and second set of trivia questions in order to obtain the above mentioned advantage.

With respect to claims 21-24, Storing in a computer system a set of trivia questions relating to content of a broadcast (col. 44, lines 55 to col. 45, lines 1-5); associating said first and second sets of trivia questions with a broadcast of said advertising content along with said show content (i.e. questions may be asked in

conjunction with the broadcast commercial and program (col. 3, lines 44-46, col. 16, lines 16-19 and col. 44, lines 55-62); transmitting said subset of trivia questions to said member and receiving said member's responses thereto via a communication medium (Figure 28, 842); scoring said member's performance in response to said subset of trivia questions (Figure 28, 838).

With respect to creating a report indicative of at least one broadcast performance factor comprising at least one recall, understanding and likeability and transmitting said report to a client. Von Kohorn teaches that the broadcast performance factor comprises recall, understanding and likeability of the broadcast content presented (col. 44 lines 55 to col. 45, lines 1-5 and col. 135, lines 5-27). With respect to preparing a report. Official notice is taken that it is old and well known to prepare a report on information gathered because such a modification would provide a detailed account of the information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included creating a report indicative of effectiveness of said advertising content based at least in part on said recall, understand and likeability and transmitting the report to said client in order to obtain the above mentioned advantage.

Response to Arguments

5. Applicant argues that although Von Kohorn teaches on col. 2, lines 52-55, "In the event of **questions or similar tasks... may be recorded prior to transmission**", Applicant argues that Von Kohorn doesn't teach that the recording means is a

computer. The Examiner wants to point out that since Von Kohorn teaches displaying the questions on electronics boards or computerized display means and questions or similar tasks...may be recorded prior to transmission then it is fair to suggest that the questions are stored in a computer. In addition, Von Kohorn teaches that other embodiments employing a digital computer suitably programmed (not shown) may also be employed. A reference disclosure must be evaluated for **all that it fairly suggests** and not only for what is indicated as preferred. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

6. Applicant argues that Von Kohorn doesn't teach selection of a subset of questions from a larger set of questions. The Examiner respectfully disagrees with Applicant because Von Kohorn clearly teaches sub-questions **derived from a parent question**. The parent questions of Von Kohorn being the larger questions and the subset of questions being selected from the parent questions.

7. With respect to Applicant arguments pertaining to claim 6, Applicant argues that Von Kohorn doesn't specifically teach the use of the Internet. The Examiner wants to remind Applicant that claim 6 was rejected under the doctrine of 103 and not under the doctrine of 102.

8. Applicant argues that while Von Kohorn col. 44, lines 55 to col. 45, lines 1-5, teaches questions directed to televisions advertisements or commercials in order to measure member's recall of the product or services being advertised, nothing in Von Kohorn discloses measuring the effectiveness of advertising based upon members'

Art Unit: 3688

responses to first and second sets of trivia questions relating to advertising content and show content, respectively. The Examiner disagrees with Applicant because the first and second sets of questions are the responses being analyzed in order to measure the effectiveness of the product and services being advertised as taught by Von Kohorn on the col. 44, lines 55 to col. 45, lines 1-5.

9. With respect to Applicant's arguments that in order to show obviousness, all limitations must be taught by the prior art. The Examiner wants to point out that Von Kohorn in combination with the Official Notices taken teaches all the limitations of the instant claims.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
6/25/2008

